



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,945	02/24/2004	James L. Tracy	CE12442JME	3815

24273 7590 01/23/2007
MOTOROLA, INC
INTELLECTUAL PROPERTY SECTION
LAW DEPT
8000 WEST SUNRISE BLVD
FT LAUDERDAL, FL 33322

EXAMINER

VUONG, QUOCHIE B

ART UNIT	PAPER NUMBER
----------	--------------

2618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/786,945

Applicant(s)

TRACY ET AL.

Examiner

Quochien B. Vuong

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3 and 5-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 9, 10, and 16 have been amended to include a limitation “wherein each of the peripheral devices operates with its own separate and independent relationship once decoupled from the electronic host device with the electronic host device”. Applicant cited page 2, paragraph 0004, lines 6-8 of the specification for supporting the amendments. However the cited portion of the specification, as quoted here “**Note that any combination of peripheral devices can operate concurrently and independently with their own separate relationship to the electronic host device**”, does not support the amendments because it does not describe that the peripheral devices operates with its own separate and independent relationship with the electronic host device when decoupled from the electronic host device.

Art Unit: 2618

It is assumed that the amended limitation is removed from independent claims 1, 9, 10, and 16. The following rejections are applied to the pending claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5, 7-12, 14-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Nickum (US 6,760,600).

Regarding claim 1, Nickum (figures 1 and 2) discloses an electronic product, comprising: an electronic host device (portable computer 12); and a plurality of peripheral devices (cellular telephone 14 and pager 16) that selectively couples and decouples to the electronic host device and activates independently of the electronic host device when decoupled from the electronic host device and further activates and operates independently of other peripheral devices that selectively couple and decouple to the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 2, Nikum discloses the electronic device further inherently comprises a means for wearing the electronic product on at least one among the

Art Unit: 2618

electronic host device and or at least one of the peripheral devices on a user (since they are portable computer, cellular phone, and pager) (column 3, lines 19-34).

Regarding claim 3, Nikum discloses wherein the peripheral devices (cellular phone 14 and pager 16) activates automatically upon being decoupled from the electronic host device (portable computer 12) (column 3, line 19 – column 5, line 13).

As to claim 5, Nikum discloses the peripheral devices (cellular phone 14 and pager 16) automatically sense the need for their own power source to become active when selectively decoupled from the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 7, Nikum discloses the peripheral devices can be selected among the group of peripherals comprising an earpiece, a display, a microphone, a user interface, a keyboard, a phone, a pager, a personal digital assistant, a camera, an imaging module, a watch, a timekeeping device, a computer, a receiver, and a transmitter (see figures 1 and 2).

Regarding claim 8, Nikum discloses any combination of the peripheral devices operates concurrently with the host and independently from each other with their own separate relationship to the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 9, Nikum (figures 1 and 2) discloses an electronic host device (portable computer 12) forming a portion of an electronic product, comprising: a power source; at least one port for receiving at least two peripheral devices (cellular phone 14 and pager 16) that independently and selectively couple and decouple to the electronic

Art Unit: 2618

host device and activate independently of the electronic host device and other peripheral devices when decoupled from the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 10, Nikum (figures 1 and 2) discloses a plurality of peripheral devices (cellular phone 14 and pager 16) forming a portion of an electronic product, comprising: a power source; a port for coupling with at least one electronic host device (portable computer 12), wherein the peripheral device selectively couple and decouple to the at least one electronic host device and activates independently of the electronic host device when decoupled from the electronic host device and other peripheral devices that work in conjunction with the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 11, Nikum discloses wherein the peripheral devices (cellular phone 14 and pager 16) activates automatically upon being decoupled from the electronic host device (column 3, line 19 – column 5, line 13).

As to claim 12, Nikum discloses the peripheral devices (cellular phone 14 and pager 16) automatically senses the need for its own power source to become active when selectively decoupled from the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 14, Nikum disclose the peripheral devices can be selected among the group of peripherals comprising an earpiece, a display, a microphone, a user interface, a keyboard, a phone, a pager, a personal digital assistant, a camera, an

Art Unit: 2618

imaging module, a watch, a computer, a timekeeping device, a receiver, and a transmitter (see figures 1 and 2).

Regarding claim 15, Nikum discloses any combination of peripheral devices operates concurrently with the host and independently from each other with their own separate relationship to the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 16, Nikum (figures 1 and 2) discloses a method of operating peripheral devices (cellular phone 14 and pager 16) independently from an electronic host device (portable computer 12), comprising the steps of: powering the electronic host device and the at least one peripheral device using a power source for the electronic host device when the at least one peripheral device is coupled to the electronic host device; detecting a selective decoupling of the at least one peripheral device from the electronic host device; powering the electronic host device using the power source for the electronic host device and independently powering the at least peripheral device with a power source for the at least one peripheral device in response to detecting the selective decoupling; and activating the peripheral device independently of any other peripheral device coupled to at least one among the electronic host device and the peripheral device (column 3, line 19 – column 5, line 13).

Regarding claim 17, Nikum discloses the step of wearing at least one among the peripheral devices and the electronic host device on a user (since they are portable computer, cellular phone, and pager) (column 3, lines 19-34).

As to claim 18, Nikum discloses the step of automatically activating the peripheral devices upon being decoupled from the electronic host device (column 3, line 19 – column 5, line 13).

As to claim 20, Nikum discloses the step of operating any combination of peripheral devices concurrently and independently with their own separate relationship to the electronic host device (column 3, line 19 – column 5, line 13).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 6, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nickum in view of Palermo et al. (US 2002/0132585).

Regarding claims 6, 13, and 19, Nickum discloses the electronic product, peripheral device, and method of claims 1, 10, and 16 above, respectively. Nickum does not disclose peripheral devices automatically sense the need for activating a new wireless link to the electronic host device using their own power source when selectively decoupled from the electronic host device. However, Palermo et al. (figure 1) disclose a peripheral device (headset 110) automatically senses the need for activating a new wireless link to the electronic host device using its own power source when selectively decoupled from the electronic host device (base station 120 and cellular phone 130) (paragraphs [0148] and [0156]). Therefore, it would have been obvious to adapt the teaching of Palermo et al. for automatically senses the need for activating a new wireless link to the electronic host device using its own power source when selectively decoupled from the electronic host device to the electronic product, peripheral devices, and method of Nickum in order to simplify the activation of the peripheral devices as suggested by Palermo et al. (paragraph [0148]).

Response to Arguments

8. Applicant's arguments filed 11/02/2006 have been fully considered but they are not persuasive.

Applicant's arguments based on the amended limitation to independent claims 1, 9, 10, and 16. However, the amended limitation introduces new matter and rejected under 112, first paragraph, above.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quochien B. Vuong whose telephone number is (571) 272-7902. The examiner can normally be reached on M-F 9:30-18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



QUOCHIE B. VUONG
PRIMARY EXAMINER

Quochien B. Vuong
Jan 18, 2007.